

REMARKS

Claims 1 and 6-12 and 14-18 are all the claims now pending in the application. Claim 13 has been canceled.

I. Claim Objection

Claim 13 stands objected to for failing to further limit the subject matter of the claim from which it depends (claim 1). Applicant has canceled claim 13 as suggested by the Examiner. Therefore, this objection is now moot.

II. Claim Rejections under 35 U.S.C. § 112

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As stated above, claim 13 has been canceled and therefore this rejection is now moot.

III. Claim Rejections under 35 U.S.C. § 103

Claims 1 and 6-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Higuchi et al. (JP 11-253578). To establish a *prima facie* case of obviousness the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations. See MPEP § 2143. Applicant respectfully submits that the reference cited above by the Examiner fails to teach or suggest all of the claim limitations as set forth in the present application. Specifically, Higuchi fails to teach or suggest that “the mantle is made of a material composed primarily of a thermoplastic elastomer selected from the group consisting of polyester, polyamide, polyolefin, and polystyrene.”

The Examiner admits in the office action that the Higuchi reference fails to teach that the main material of the mantle is “a thermoplastic elastomer selected from the group consisting of polyester, polyamide, polyolefin, and polystyrene.” Specifically, the Examiner states that the “intermediate layer [of Higuchi] is formed of a polyurethane resin as the main material, in which contains a thermoplastic polyurethane elastomer.” Thus, the Examiner admits that the Higuchi teaches that the main material of the mantle layer is polyurethane.

The Examiner seems to believe that other elastomers, such as polyamide, can be added to the polyurethane, and therefore it would have been obvious to use such elastomers as the primary material of the mantle layer. Higuchi maintains that the main/primary material of the mantle layer is polyurethane and not any other type of material. Furthermore, Higuchi teaches that the polyurethane consists of a polyol and a diisocyanate. The polyol, in Higuchi, can be a polyester system polyol. However, Higuchi does not teach or suggest that a polyester or polyamide can be used as the main material of the mantle. Higuchi only teaches that polyester can be a part of the polyurethane that is used as the main material. Nowhere in Higuchi does it teach or suggest that polyester alone can be used as the main material of the mantle as the Examiner suggests. In fact, the Examiner points to no such teaching in the Higuchi reference. Thus, Higuchi fails to teach or suggest that “the mantle is made of a material composed primarily of a thermoplastic elastomer selected from the group consisting of polyester, polyamide, polyolefin, and polystyrene.”

Additionally, the Examiner again alleges that the claimed compression ratio would be an obvious feature of the Higuchi golf ball because one skilled in the art would have found it obvious to have such a compression ratio “in order to obtain a golf ball having good feel and

flight distance.” However, when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d at 1316-1317 (citing *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)); *see also* MPEP § 2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”). The Examiner points to no such teaching within Higuchi to modify the compression ratio to be at least 0.98. The Examiner instead makes only a bald unsupported conclusion as to the obviousness of this feature. Broad conclusory statements regarding the teaching of references, alone, are not evidence. *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000) (Emphasis added). Since the Examiner has not provided a convincing line of reasoning as the obviousness of the compression ratio, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness.

In view of the remarks above, Applicant requests that the rejection of claims 1, 6-12 and 14-18 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

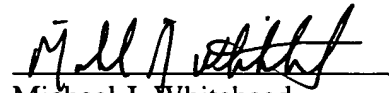
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/667,301

Attorney Docket No.: Q60969

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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